1606.72574 PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Pommereau
Serial No.:	10/525,900
Conf. No.:	9652
Filed:	February 25, 2005
For:	GOLF BALL DISPENSER
Art Unit:	3653
Examiner:	Michael E. Butler

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. PART 41

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Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is in support of Applicants' Notice of Appeal and Pre-Appeal Brief Request dated August 14, 2009 from the Final Rejection dated April 14, 2009.

REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on Appeal is Claude Pommereau by virtue of the Declaration filed on February 25, 2005.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to this application.

STATUS OF CLAIMS

Claims 1, 7, 8, 15, 16, 28 and 29 are pending in the application. Claims 2-6, 9-14 and 17-27 have been withdrawn. No claims have been allowed. Claims 1, 7, 8, 15, 16, 28 and 29 stand rejected in a final rejection mailed on April 14, 2009 and are appealed.

STATUS OF AMENDMENTS

Amendment A was filed on January 21, 2009, and was the last amendment filed. All amendments have been entered and considered. No amendments were filed subsequent to the final rejection mailed on April 14, 2009.

SUMMARY OF CLAIMED SUBJECT MATTER

The rejections of claims 1 and 29 are appealed. Claim 1 is independent. Claim 28 depends from claim 1 and claim 29 depends from claim 28. Claims 7, 8, 15, 16 and 28 depend from claim 1 and therefore, stand or fall with claim 1. A concise summary of the appealed claims follows.

Referring to independent claim 1, a golf ball dispenser is claimed and includes an upper container that contains golf balls and a flange that receives the balls coming from the container (Page 8, lines 5-15) (Figs. 1-3). The flange also supplies the golf balls to a dispenser arm that dispenses the balls one-by-one (Page 8, lines 9-15; Page 8, line 26 to Page 9, line 2) (Figs. 2-3). The dispenser arm is arranged substantially vertically in a rest position and includes means arranged in the upper part of the dispenser arm close to the flange to receive balls one-by-one from the container, a lower end that dispenses the balls and a pivoting means arranged in the upper end of the dispenser arm close to the flange for pivoting the arm around a horizontal axis during a golf ball dispensing from the rest position to the dispensing position (Page 8, lines 9-15; Page 8, line 26 to Page 9, line 2) (Figs. 1-3). The dispensing arm returns to the rest position from the dispensing position without a spring or counterweight to aid in the return from the dispensing position (Page 2, lines 9-12; Page 2, line 21 to Page 3, line 3) (Figs. 1-5).

Referring now to dependent claim 28, which depends from claim 1, and recites that the inside of the dispenser arm comprises several non-concentric rings to slow down the drop of the golf ball (Page 14, lines 18-19) (Figs. 12-14).

Referring now to claim 29, which depends from claim 28, and recites that the rings are arranged so that the distance between two consecutive rings decreases closer to the lower end of the dispenser arm (Page 14, lines 27-30) (Figs. 12-13).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of independent claim 1 and the rejection of dependent claim 29 are to be reviewed on appeal. Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,549,518 to Wang. Claim 1 also stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,624,325 to Smith. Claim 29 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Wang and U.S. Patent No. 3,738,662 to Hodgin. Claim 29 also stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Smith and Hodgin. Additionally, claims 1, 7-8, 15-16 and 28-29 stand rejected under 35 U.S.C. §112, second paragraph.

ARGUMENT

The present invention provides a golf ball dispenser that places a single golf ball on a tee, such as at a driving range, so that the golfer does not have to bend down and pick up a ball and then position the ball on the tee by hand. As explained in the present

application, existing golf ball dispensers are complex and include several moving, interacting parts. These golf ball dispensers typically include dispensing arms that pivot around a vertical or horizontal axis. Most of these dispensers utilize a counterweight or spring to bias the dispensing arm from a dispensing position back to a rest position. Counterweights and springs are additional mechanical parts that can rust and/or fail over time. Wear can also cause these parts to become less effective (see Smith, Col. 7, lines 43-47). Such dispensers therefore require extra maintenance to inspect, repair or replace these parts.

The present invention addresses these and other problems by providing a golf ball dispenser that pivots due to gravity without the use of a counterweight or spring to bias the dispensing arm from a dispensing position to the rest position. Such a feature is an advantage over existing dispensers because there are less parts to repair or replace, which saves money, and the operation of the dispenser remains consistent over time because it does not have any parts such as counterweights or springs that will wear down and become less effective.

The Examiner rejects claim 1 based on Wang and separately on Smith. Wang discloses a golf ball dispensing device that includes a supply arm 32 pivotally mounted to a storage housing for dispensing golf balls. Smith discloses a golf ball teeing apparatus that includes a container for holding several golf balls and a dispensing mechanism for delivering the balls to a tee.

Issues on this appeal include:

I. Whether Wang contemplates dispensing a golf ball without using a counterweight or spring.

II. Whether Smith disclosing dispensing a golf ball without the use of a counterweight or spring.

III. Whether Wang and Smith contemplate a dispensing arm that pivots from a downward position to an upward position.

IV. Whether the combination of Smith and Hodgin or Wang and Hodgin discloses a dispensing arm including non-concentric rings to slow down the drop of the golf ball where the distance between two of the rings decreases at the lower end of the dispensing arm.

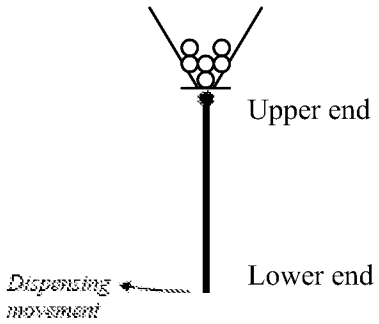
V. Whether the rejection of claims 1, 7, 8, 15, 16, 28 and 29 under Section 112, second paragraph, should be reversed based on the arguments presented herein.

I. The Examiner Clearly Misrepresents the Content of Wang and Ignores Required Claim Elements

A. Wang's Dispensing Arm is Configured Differently from the Claimed Dispensing Arm

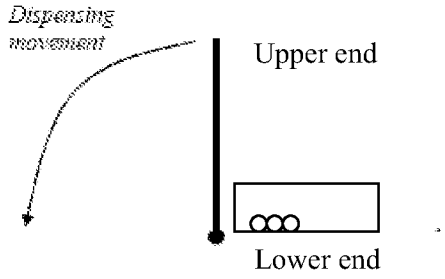
Claim 1 of Applicant's application recites, among other things, a golf ball dispenser that includes an upper container that holds the golf balls and a dispenser arm, where the dispenser arm includes "an upper part close to the flange to receive balls one by one from the container, a lower end intended to dispense balls, and a pivoting means arranged in the upper end of the dispenser arm close to the flange for pivoting about a horizontal axis" to dispense a golf ball. As shown in the diagram below, the dispenser arm pivots at its upper part or upper end and also receives golf balls at this end. The

lower end of the dispenser arm moves laterally and upwardly to dispense the golf balls onto a tee.



Present invention

In contrast, as stated on page 9 of Applicant's response filed January 21, 2009, Wang discloses a supply arm 32 pivotally mounted in and normally vertically erected on a housing 1. As shown in Figs. 3 and 4 of Wang, the upper part or upper end 323 of the pivotal supply arm 32 dispenses the balls and the lower part or end 34 receives the balls from the channel 13 in the housing. The supply arm 32 is mounted around a pivot 31 arranged at the lower end of the pivotal supply arm 32. Thus as shown in the diagram below, the supply arm 32 in Wang pivots and receives golf balls at the lower end of the arm where the arm pivots downwardly to a tee to dispense the balls from the upper end of the arm.



Wang & Smith

The Examiner therefore misrepresents the teachings of Wang because Wang discloses an arm that pivots about its lower end and also receives golf balls at the lower end and dispenses the balls at its upper end. This is contrary to claim 1, which recites the opposite configuration, where the arm pivots about and receives golf balls at the upper end and dispenses golf balls at the lower end. The configuration of Applicant's golf ball dispenser is an advantage over existing golf ball dispensers, such as the dispenser disclosed by Wang, because the arm in Applicant's dispenser moves from a dispensing position to a rest position due to gravity and does not require additional parts, such as springs and/or counterweights, for such movement, which can rust or break over time thereby increasing costs.

Furthermore, Wang does not disclose that its dispensing arm can be configured to pivot upwardly from a rest position. Wang specifically discloses that its golf ball dispensing device is to be placed on the ground next to a mat 8 such as those commonly found at a driving range (Col. 2, lines 2-7; Figs. 3-4). Because the device is on the ground, the dispensing arm 3 must pivot downwardly from an upper position to a lower position as shown in Fig. 5.

Also in Wang, the track or channel formed in the dispensing arm has an open top (i.e., not tubular or enclosed as in the present invention). Therefore, even if the dispensing arm was configured to extend below the housing and pivot upwardly similar to the claimed invention, the dispensed golf balls would fall out of the track and never be positioned on a tee. This is further evidence that Wang does not disclose or contemplate such a configuration and that Wang cannot be modified to have such a configuration.

B. Wang is Missing a Required Element of Claim 1

Claim 1 recites, among other things, that the dispensing arm of the golf ball dispenser returns to "said rest position from said dispensing position without a spring or a counterweight." (Emphasis Added). Thus, claim 1 specifically excludes the use of a spring or counterweight to bias the dispensing arm from the dispensing position to the rest position.

Section 2173.05(i) of the MPEP states that "[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph." Section 2173.05(i) further states that "[a]ny negative limitation or exclusionary proviso must have basis in the original disclosure." If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019; 194 USPQ 187, 196 (CCPA 1977).

Applicant's application specifically discloses that the dispensing arm recited in claim 1 moves from the dispensing position to the rest position due to gravity without the use of a spring or counterweight (see the Specification, Page 2, line 21 to Page 3, line 3; Figs. 1-5).

Wang discloses that its arm 32 includes a counterweight 4 to cause the arm 32 to pivot back to the rest position shown in Fig. 3 (see Col. 4, lines 23-31). Wang therefore fails to disclose a golf ball dispenser having a dispensing arm that moves without a counterweight as recited in claim 1 of Applicant's application.

Applicant therefore submits that Wang is missing a required element of claim 1 thereby making the rejection of the claims over Wang improper. Accordingly, Applicant requests that the rejection of claim 1 be withdrawn.

II. The Examiner Clearly Misrepresents the Content of Smith and Ignores Required Claim Features

A. Smith's Dispensing Arm is Configured Differently from the Claimed Dispensing Arm

The golf ball teeing apparatus in Smith has a similar operation to the golf ball dispenser in Wang. Smith discloses a teeing apparatus that includes a pivotal supply arm 20 including an upper end or supply part 54 and a lower end having a feeding part that receives the golf balls. The arm 20 pivots about a pivot 48 located at the lower end of the arm. As shown in the diagram above for Smith, the upper end of the arm 20 pivots

about the lower end so that the upper end moves downwardly from the rest position to the dispensing position.

Smith also does not disclose or suggest an apparatus that has a dispensing arm that pivots upwardly from a rest position to a dispensing position. As shown in Figs. 1 and 2 of Smith, the pivoting portion of the apparatus is connected to a frame 14. The frame 14, in turn, is connected to a base 12 having a planar surface that sits on the ground or other underlying surface such as on or next to a mat at a driving range (Col. 4, lines 18-20; line 31-35 and lines 52-55). Smith does not disclose that its apparatus could be positioned above a tee or that such positioning would be desirable.

Additionally, the dispensing arm 20 in Smith has a U-shaped, open channel that is sized to guide a golf ball as it rolls to the dispensing end of the arm. As explained above, such a channel would not retain the golf balls if the arm 20 were constructed to extend below the storage container 16 and pivot upwardly as in the claimed invention. Instead, most of the golf balls would fall off of the arm 20 and onto the ground. Thus, Applicant submits that Smith fails to disclose or suggest a golf ball dispensing apparatus that is constructed or operates similar to the claimed dispenser.

For these reasons, Applicant submits that the Examiner misrepresented Smith in rejecting the claims in Applicant's application and thereby requests that the rejection be withdrawn.

B. Smith is Missing a Required Element of Claim 1

Applicant further submits that Smith does not disclose all of the elements of claim 1. As stated above, claim 1 recites, among other things, that the dispensing arm returns to the "rest position from said dispensing position without a spring . . ." (Emphasis Added).

In contrast, Smith clearly discloses a spring 56 having one end secured to the front wall 38 and a second end 59 secured to the bracket 50 to bias the arm 20 upwardly from the dispensing position to the rest position (see Figs. 1 and 2; Col. 5, lines 34-40). Smith does not disclose that its apparatus operates or can operate without the use of the spring 56. Therefore, Smith fails to disclose all of the elements of claim 1.

Applicant therefore submits that Smith is missing a required element of claim 1 and therefore the rejection of the claims over Smith is improper. Accordingly, Applicant requests that the rejection of claim 1 be withdrawn.

III. The Examiner Clearly Misrepresents the Content of Hodgin to Reject Claim 29

Claims 1 and 28-29 are rejected as being unpatentable over the combinations of Smith and Hodgin and Wang and Hodgin. In particular, the Examiner states that Hodgin discloses the subject matter of claim 29. Claim 29 depends from claim 28 and further recites that the non-concentric rings of the dispenser arm "are arranged so that the distance between two consecutive rings decreases closer to the lower end of the dispenser arm." Hodgin does not disclose or suggest such subject matter.

Hodgin discloses a golf ball teeing device 10 including a pivoting arm 28 having a dispensing end 80 with two ring-like structures (see Fig. 2). There are only two ring structures disclosed by Hodgin, which are separated by a designated distance. Hodgin does not disclose additional ring structures where the distance between the ring structures decreases closer to the lower end of the dispenser arm. It is impossible for the distance between the ring structures to "decrease" where there are only two ring structures shown having a single distance or space between them.

Applicant therefore submits that the Examiner clearly erred in rejecting claim 29 over the combinations of Smith and Hodgin and Wang and Hodgin where Hodgin fails to disclose the subject matter of claim 29.

For at least this reason, Applicant submits that the rejection of the claims over the combinations of Smith and Hodgin and Wang and Hodgin are improper and requests that the rejections be withdrawn.

IV. Applicant Intends to Amend Claim 1 to Overcome the Indefiniteness Rejection Under § 112

The pending claims, claims 1, 7-8 and 28-29, are rejected under § 112 because the Examiner states that the terms "or" and "without" in the final line of claim 1 are indefinite. Applicant intends to amend claim 1 so that the final line states that the dispensing arm returns to the rest position from the dispensing position "without a spring and without a counterweight." As described below, the present golf ball dispenser moves

from the dispensing position back to the rest position using solely gravity and without any type of spring and without any type of counterweight to assist that movement.

CONCLUSION

For the foregoing reasons, Appellant respectfully requests that the rejection of claims 1, 7, 8, 15, 16, 28 and 29 be reversed, with instructions to allow this application. Reversal of the rejections of these claims is called for based on at least the following reasons:

1. The Examiner misinterprets Wang and thereby improperly rejects claims 1, 7, 8, 15, 16, 28 and 29

2. Wang fails to disclose or suggest a golf ball dispenser that operates "without a counterweight" as required by claim 1

3. The Examiner misinterprets Smith and thereby improperly rejects claims 1, 7, 8, 15, 16, 28 and 29

4. Smith fails to disclose or suggest a golf ball dispenser that operates "without a spring" as required by claim 1

5. The Examiner clearly misrepresents Hodgin and thereby improperly rejects Claim 29

6. Applicant intends to amend Claim 1 to overcome the indefiniteness rejection under § 112

Respectfully submitted,

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CLAIMS APPENDIX

1. (Previously Presented) A golf ball dispenser comprising an upper container to contain golf balls and a flange to receive the balls coming from the container and supply a dispenser arm with balls one by one, such dispenser arm being arranged substantially vertically in a rest position and comprising means, arranged in the upper part close to the flange to receive balls one by one from the container, a lower end intended to dispense balls, and a pivoting means arranged in the upper end of the dispenser arm close to the flange for pivoting around a horizontal axis during a golf ball dispensing from said rest position to a dispensing position, said dispensing arm returning to said rest position from said dispensing position without a spring or a counterweight.

2. (Withdrawn) The dispenser according to claim 1, wherein the flange comprises a tubular receptacle through which the golf balls from the container pass to reach the dispenser arm.

3. (Withdrawn) The dispenser according to claim 2, wherein the receptacle comprises an upper part with a diameter designed to guide the golf balls from the container one by one, and a lower part with a larger diameter than the upper part.

4. (Withdrawn) The dispenser according to claim 2, wherein the dispenser arm is partly inserted into a lower part of the receptacle, the pivot axis of the dispenser arm being securely attached to such lower part of the receptacle.

5. (Withdrawn) The dispenser according to claim 2, wherein the upper end of the dispenser arm comprises a bevel to allow the dispenser arm to pivot in the receptacle.

6. (Withdrawn) The dispenser according to claim 5, wherein the bevel is made along a predetermined angle corresponding to the maximum pivot of the dispenser arm.

7. (Previously Presented) The dispenser according to claim 1, wherein the upper end of the dispenser arm comprises means of preventing a second ball from entering the dispenser arm when the dispenser arm pivots to release a first ball already present in the dispenser arm.

8. (Previously Presented) The dispenser according to claim 7, wherein the prevention means consist of a rim of the end of the dispenser arm.

9. (Withdrawn) The dispenser according to claim 2, wherein the receptacle comprises a bevel at its lower end acting as a stop for the pivoting of the dispenser arm.

10. (Withdrawn) The dispenser according to claim 2, wherein the internal diameter of the dispenser arm is substantially equal to the internal diameter of the upper part of the receptacle.

11. (Withdrawn) The dispenser according to claim 2, further including a protruding wedge, arranged on the inner surface of the lower part of the receptacle and cooperating with an opening made in the dispenser arm, such wedge acting to block the ball inserted in the dispenser arm, with the next ball resting on the first ball; and in that the wedge is shaped so as to release the golf ball present in the dispenser arm when the said arm pivots.

12. (Withdrawn) The dispenser according to claim 11, wherein the wedge has a slope designed to release the ball present in the dispenser arm when the said dispenser arm reaches a predetermined pivoting angle.

13. (Withdrawn) The dispenser according to claim 1, further including magnets to hold the dispenser arm either in the rest position or in the dispensing position.

14. (Withdrawn) The dispenser according to claim 13, wherein the magnets are arranged in the receptacle.

15. (Previously Presented) The dispenser according to claim 1, wherein the dispenser arm comprises a brake allowing for the golf ball to be deposited accurately.

16. (Previously Presented) The dispenser according to claim 15, wherein the brake is an "S" shaped bend made close to the lower end of the dispenser arm.

17. (Withdrawn) The dispenser according to claim 1, wherein the lower end of the dispenser arm has a cut-out to prevent it from taking with it a golf ball that has just been deposited.

18. (Withdrawn) The dispenser according to claim 1, wherein the flange comprises a tripod to hold the dispenser in an upper position.

19. (Withdrawn) The dispenser according to claim 18, wherein the tripod comprises telescopic legs.

20. (Withdrawn) The dispenser according to claim 18, wherein the tripod comprises two front legs arranged on a vertical plane perpendicular to the direction of movement of the dispenser arm, these two legs facing the user, and a third rear leg arranged on the opposite side to the two front legs relative to the flange.

21. (Withdrawn) The dispenser according to claim 18, wherein the two front legs are such that the first leg is approximately vertical and the second leg is sloping to balance the tripod.

22. (Withdrawn) The dispenser according to claim 21, wherein the flange comprises a reversible block to position the two front legs in a first position in which the left leg is sloping and in a second position in which the right leg is sloping.

23. (Withdrawn) The dispenser according to claim 20, wherein the third rear leg comprises a hook designed to receive a weight to increase the balance of the tripod.

24. (Withdrawn) The dispenser according to claim 18, wherein the three legs are removable and have a diameter such that they can be housed inside the dispenser arm for transport.

25. (Withdrawn) The dispenser according to claim 2, wherein the receptacle is height-adjustable relative to the flange.

26. (Withdrawn) The dispenser according to claim 1, wherein the upper container consists of a vertical barrel arranged above the flange, the axis of rotation of the barrel being offset relative to the axis of the upper opening of the receptacle.

27. (Withdrawn) The dispenser according to claim 26, wherein the barrel is topped with a disc comprising peripheral openings facing the cavities in the said barrel in order to guide the balls into these cavities, and a central protrusion to guide the balls towards these peripheral openings, and in that the dispenser also comprises a removable funnel, flared towards the top, that engages with the edge of the disc.

28. (Previously Presented) The dispenser according to claim 1, wherein the inside of the dispenser arm comprises several non-concentric rings to slow down the drop of the golf ball.

29. (Previously Presented) The dispenser according to claim 28, wherein the rings are arranged so that the distance between two consecutive rings decreases closer to the lower end of the dispenser arm.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None